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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/825,969
Filing Date: April 04, 2001
Appellant(s): DOERR ET AL.

MAILED

DEC 31 2007

GROUP 3600

Jack M. Cook, Reg. 56, 098
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/4/07 appealing from the Office action
mailed 10/24/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 2/23/07 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

The changes are as follows:

- Claims 1,4-9,12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (USPN 5,924,074) in view of Lewis et al (US 2003/0200119 A1).

- This is listed by applicant as a rejection under 35 USC 102(a).

Furthermore, claim 11 was cancelled by the Appellant in the 2/23/07

After Final amendment, and therefore should no longer be an issue for appeal.

- Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Lewis as applied to claim 1 above, and further in view of Denny (USPN 6,687,676).
- Claims 13, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Lewis as applied to claim 1 above, and further in view of Mayaud (USPN 5,845,255).
- Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Lewis as applied to claim 19 above, and in view of Lee ("Fujitsu Pen Computer Will Ship with Windows 95").

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 5,845,255 A	MAYAUD	12-1998
US 5,924,074A	EVANS	07-1999
US 6,687,676 B1	DENNY	02-2004
US 2003/0200119 A1	LEWIS et al	10-2003

Lee, Yvonne; "Fujitsu Pen Computer Will Ship with Windows 95," Mar. 18 1996,
InfoWorld, vol. 18, no. 12, page 30 (2 pages)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4-9, 12 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (USPN 5,924,074) in view of Lewis et al (US 2003/0200119 A1).

[claim 1] Evans discloses a decision support system comprising:

- a hand-held terminal usable during examination and providing a display and physician input device; (see Abstract, col. 2, lines 47-50; col. 5, lines 8-21)
- a terminal server communicating with the hand-held terminal and executing a stored program to:
 - o present on the display of the hand-held terminal a navigation menu presenting diagnosis codes representing different medical diagnoses; (Fig. 20; col. 11, lines 37-50)

- accept from the physician input device of the hand-held terminal a selection identifying a specific diagnosis code from the diagnosis codes; and (col. 11, lines 37-50)
- enable access to additional physician support features related to a treatment of a medical diagnosis represented by the specific diagnostic code. (col. 11, lines 54-60; Figures 18, 20—procedures/treatments provided relating to diagnosis and diagnosis code; medication manager also available)

Claim 1 further recites that the navigation menu is configured to restrict to additional features related to a treatment of a medical diagnosis represented by the specific diagnosis code until a diagnosis code is selected.

Evans discloses a method wherein the navigation menu presents diagnosis codes representing different medical diagnoses; (Fig. 20; col. 11, lines 37-50) and further discloses access to additional physician support features related to a treatment of a medical diagnosis represented by the specific diagnostic code. (col. 11, lines 54-60; Figures 18, 20—procedures/treatments provided relating to diagnosis and diagnosis code; medication manager also available). However, Evans does not expressly disclose that access to the additional support features is restricted until the diagnosis code is selected.

Lewis et al discloses a method wherein the user selects the diagnosis code to access additional support features relating to treatment of the diagnosis. (par. 79, lines 17-25; par. 80-83—The selected diagnostic codes/ICD-9 then lead to the health services that correspond to treating such diagnoses.) At the time of the applicant's

invention, it would have been obvious to one of ordinary skill in the art to modify the method of Evans with the teaching of Lewis to restrict to additional features related to a treatment of a medical diagnosis represented by the specific diagnosis code until a diagnosis code is selected. As suggested by Lewis, one would have been motivated to include this feature to ensure that a user is allowed to order the most appropriate healthcare treatments/services, leading to fewer problems in claims processing by health insurers. (par. 83).

[claim 4] Evans teaches a decision support system wherein physician support features include display of physician educational information about at least one of the diagnosis represented by the diagnosis code and treatment of the medical diagnosis. (Figures 18,20; col. 11, lines 10-30; 37-54)

[claim 5] Evans teaches a support system wherein additional physician support features include hyperlinks to physician educational information. (Figure 14,24; col. 13, lines 20-30)

[claim 6] Evans teaches a decision support system wherein the terminal server further accepts from the physician input device of the hand-held terminal a selection identifying a specific patient, (col. 6, lines 55-63) and wherein the additional physician support features include display of a history of related diagnoses and treatments for the patient. (col. 6, line 62-col. 7, line 40; Figures 7-8)

[claim 7] Evans teaches a support system wherein the display of the history of related diagnoses and treatments for the patient includes identification of at least one medication used in the treatment. (col. 7, lines 41-52)

[claim 8] Evans teaches a system wherein the diagnosis codes are codes of the

international Classification of Diseases developed by the World Health Organization. (Figure 14; col.9, lines 4-7)

[claim 9] Evans teaches a support system wherein the selection is a direct selection of a diagnosis code displayed by the navigation menu. (col. 11, lines 46-50)

[claim 12] Evans teaches a decision support system wherein the additional physician support features include a listing of treatment options for treating an ailment identified by the specific diagnosis code. (col. 11, lines 14-22—lists medications that may correspond with a diagnosis)

[claim 14] Evans teaches a decision support system wherein additional physician support features include a listing of specific drugs associated with treating the medical diagnosis presented by the specific diagnosis code. (col. 11, lines 10-22; Figures 20-21)

[claim 15] Evans teaches a support system, which include access to a searchable database of drugs. (Figures 21-22; col. 12, lines 6-25)

[claim 16] Evans teaches a system wherein the terminal server and the hand-held terminal provide interfaces connecting to the Internet and wherein the terminal server connects with the hand-held terminal via the Internet. (col. 12, lines 56-63; col. 13, lines 13-30)

[claim 17] Evans teaches a support system which provides wireless communication among the devices (i.e. between the hand-held terminal and the terminal server) (col. 2, lines 45-50; col. 13, lines 13-30)

[claim 18] Evans teaches system wherein system wherein the physician input device includes a keyboard or stylus entry device (col. 7, lines 10-14)

[claim 19] Evans teaches a decision support system wherein the display is a graphic display

providing for the display of text and images. (Figure 8; col. 7, lines 11-40)

3. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Lewis as applied to claim 1 above, and further in view of Denny (USPN 6,687,676)

[claims 2-3] Evans and Lewis disclose a decision support system, as explained in the rejection of claim 1. Evans further discloses that the system provides additional physician support tools (col. 7, lines 41-64), but does not expressly disclose that the system prints patient handouts about at least one of the diagnosis (represented by the specific diagnosis code) or the treatment of the diagnosis, and printing a prescription for treatment of the medical diagnosis. Denny discloses a system, which prints a prescription for the patient (i.e. a handout about the treatment and a prescription for treatment) (col. 6, line 51-59). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans and Lewis in combination with the teaching of Denny to provide patient handouts related to treatment and printouts of a prescription for treatment. As suggested by Denny, one would have been motivated to include this feature to ensure that the patient is given a proper dosage and special instructions for treatments (col. 1, lines 42-55) and to facilitate the retrieval and fulfillment of a prescription at a patient-selected pharmacy (col. 7, lines 6-13)

4. Claims 13, and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Lewis as applied to claim 1 above, and further in view of Mayaud (USPN 5,845,255)

[claim 13] Evans discloses a decision support system that provides hand-held terminal with navigation menu which includes a lists of diagnosis codes and treatment codes for selection by a user (e.g. physician) (Figure 20, col. 11, lines 37-50), but does not expressly disclose that the diagnosis and treatment codes are listed by the frequency of prior use by a particular physician or group of physicians. Mayaud discloses an adaptive system in which treatments (i.e. prescribed drugs) may be displayed based upon frequency of use (i.e. how often they are ordered by the treating physician(s)). (col. 12, lines 45-54) At the time the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans and Lewis in combination with the teaching of Mayaud to display treatment information based upon the frequency with which it is used by the physician(s). As suggested by Mayaud, one would have been motivated to include this feature to make the system more valuable with increased use, as it adapts to the user's environment and preferences. (col. 12, lines 54-63)

[claims 21-22] Evans discloses a decision support system that provides navigation menu lists of diagnosis codes for selection by a user (e.g. physician) (Figure 20, col. 11, lines 37-50), but does not expressly disclose that the diagnosis codes representing the different medical diagnoses are arranged in a list within the navigation menu by the frequency of prior use by a

particular physician or group of physicians. Mayaud discloses an adaptive system in which disease conditions may be displayed based upon frequency of use (i.e. how often they are encountered by the treating physician(s)). (col. 12, lines 45-54) At the time the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans and Lewis in combination with the teaching of Mayaud to display diagnosis information (e.g. codes/conditions) based upon the frequency with which it is encountered by the physician(s) using the system. As suggested by Mayaud, one would have been motivated to include this feature to make the system more valuable with increased use, as it adapts to the user's environment and preferences. (col. 12, lines 54-63)

5. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Lewis as applied to claim 19 above, and in view of Lee ("Fujitsu Pen Computer Will Ship with Windows 95").

[claim 20] Evans teaches a decision support system as explained in the rejection of claim 19. Evans further discloses that the display of the system is a graphic display providing for the display of text and images (Figure 8; col. 7, lines 11-40), but does not specifically disclose the resolution of the system display. Lee discloses the use of higher resolution displays (e.g. resolution of at least 600 x 200) to view data on handheld computers. (page 1, par. 6) At the time of the Applicant's invention it would have been obvious to one of ordinary skill in the art to combine the system of Evans and Lewis in combination with the teaching of Lee include the use of a higher resolution handheld display unit in the system of Evans. As suggested by Evans, one would have

been motivated to include this feature to improve the detail displayed in the graphical images (e.g. x-rays) (col. 7, lines 34-40; col. 13, lines 13-20), thereby increasing the accuracy of diagnoses made through such images.

(10) Response to Arguments

(A) On pages 3-4 and 6 of the Appeal Brief filed 10/4/07, Appellant argues that the combination of Evans in view of Lewis is improper because Evans teaches away from the claimed invention.

In response, the Examiner submits that Evans does not teach away from the Appellant's invention or from the teachings of Lewis. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994).

Objects of the Evans invention include providing patient records at the point-of-care, and enabling the analysis of patient data by providing access to reference databases for diagnoses, procedures, and medication. (Evans: col. 2, lines, lines 62-67 in particular; lines 23-67)

Evans discloses that healthcare provider selects/enters a diagnosis (col. 11, lines 17-19; lines 40-46). Evans also discloses that the user is provided with additional information (i.e. additional support features) regarding suggested treatments or

procedures as *indicated by the diagnosis*. (i.e. suggesting that a diagnosis is entered first) (col. 11, lines 22-27) It is submitted that this would at least suggest to one of ordinary skill in the art that the selection of diagnosis provides the user with access to the additional support features such as treatment or medication recommendations. The secondary reference, Lewis, discloses a method wherein a specific diagnosis code is entered (i.e. ICD-9), then additional support features are accessed.

Contrary to appellant's assertion, the ability to access additional support information after entry of a diagnostic code does not destroy the intended functions and purposes of the Evans system and method. Moreover, at the time the Appellant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Evans with the teaching of Lewis to restrict to access to additional support features until a specific diagnosis code is selected. As suggested by the Lewis reference, one would have been motivated to include this feature to ensure that a user is allowed to order the most appropriate healthcare treatments/services corresponding to the diagnosis, leading to fewer problems in claims processing by health insurers. (par. 83).

(B) On pages 4-6 of the Appeal Brief filed 10/4/07, Appellants argue that Evans does not disclose the invention as claimed. In particular, the Appellant argues that Evans does not use the selection of a diagnosis code as a gatekeeper to accessing additional information.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Evans teaches a plurality of "additional support features" to aid physicians in the diagnosis, and treatment of patients. The features include but are not limited to Practice Guidelines of Figure 11 (see also: col. 7, line 54-57); the Medication Data Capture feature of Figures 4 and 9 (see also col. 7, lines 45-52); and the Diagnosis Module of Figure 21, (further described in the citation Figure 20, col. 11, lines 37-50).

While suggested, Evans does not *expressly* disclose that access to additional support features is restricted until the specific diagnosis code is selected. However, Evans does disclose that healthcare provider selects/enters a diagnosis (col. 11, lines 17-19; lines 40-46). Evans also discloses that the user is provided with additional information (i.e. additional physician support features) regarding suggested treatments or procedures as *indicated by the diagnosis*. (i.e. suggesting that a diagnosis is entered first) (col. 11, lines 22-27)

Lewis et al has been provided to disclose a method wherein the user selects the diagnosis code to access additional support features relating to treatment of the diagnosis. (par. 79, lines 17-25; par. 80-83; Figure 4F—The selected diagnostic codes/ ICD-9 then leads to the health services that correspond to treating such diagnoses.) At the time of the applicant's invention, it would have been obvious to one of ordinary skill

in the art to modify the method of Evans with the teaching of Lewis with the motivation of ensuring that a user is allowed to order the most appropriate healthcare treatments/services, leading to fewer problems in claims processing by health insurers, as suggested by Lewis (par. 83).

It was the combination of references, not Evans alone, which was provided to address the restricted access to additional support features until the entry of a diagnosis code.

It is further noted that the current claim language fails to provide any clarification or description regarding the type of features specified with the recited "additional physician support features." Furthermore, the claim language also fails to explain the manner by which aspects/elements of the additional physician support are "restricted." (e.g. Does the navigation menu not provide descriptions of diagnosis codes? Does the navigation menu not allow for the input of patient identifier data/patient names to retrieve patient records until a diagnosis code is entered? Does restricted access refer to the appearance of additional windows or navigation menus?)

In the absence of such clarification, the Examiner has given the terms the broadest reasonable interpretation and applied art accordingly. "Additional physician support features" may include any information used by the physician to aid in the treatment and/or diagnosis of the patient.

(C) On pages 6-7, Appellant argues that claim Evans does not disclose “hyperlinks to additional physician educational information,” as required by claim 5.

It is noted that the terms “additional physician support features” (claim 1) and “physician educational information related to at least one of diagnosis and treatment...” (claim 4) are broad and may include any information used by the physician to aid in the treatment and/or diagnosis of the patient. (e.g. legacy patient records, treatment look-up, diagnosis description look-up; medication manager)

Furthermore, Evans discloses a system wherein the additional physician support features include hyperlinks. (Figure 14, 24: Col. 13, line 20-30) Evans is an internet based system, including a vast network of servers and websites, which allows the user/physician to point and click to access data from disparate locations using web browsers. (See also col. 14, line 54-col. 14, line 20) Furthermore, Evans discloses that the patient records include HTML documents (Figure 14)

Appellant acknowledges the use of the domain names in the Evans reference, but suggests that the use of domain names precludes the use of hyperlinks. However, the Examiner understands a hyperlink to be any word, symbol, or phrase which connects one to an element in a webpage, website or HTML document. The domain name itself may function as a hyperlink if, for example, it is embedded within another webpage (and can transfer you to another part of the webpage).

(D) On page 8, Appellant argues that Denny does not disclose “Denny does not teach or suggest the use of diagnosis codes,” or “printing a patient handout about the

diagnosis represented by the entered diagnosis code or the treatment of the medical diagnosis.”

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the ability to print handouts including diagnosis and treatment information or print prescriptions from a hand-held) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Neither claim requires printing from the handheld device itself.

The language of claims 2 and 3 recite that the additional support features include:

- printing of patient handouts about at least one of the diagnosis *represented by* the specific diagnosis code and the treatment of the medical diagnosis (claim 2)
- printing of a prescription for the treatment of the medical diagnosis. (claim 3)

Evans and Lewis in combination, disclose a decision support system, requiring the use of the handheld device and the entry of a specific diagnosis code, as explained in

the rejection of claim 1. Evans further discloses that the system provides additional physician support tools (col. 7, lines 41-64), but does not expressly disclose that the system prints patient handouts about at least one of the diagnosis (represented by the specific diagnosis code) or the treatment of the diagnosis, and prints a prescription for treatment of the medical diagnosis.

Denny was relied upon to disclose a system, which prints a prescription for the patient. (i.e. a patient handout about the treatment and a prescription for treatment) (col. 6, line 51-59). (See also col. 10, line 50-col. 11, line 20) In the Denny reference the patient receives a printed prescription for the treatment of a medical diagnosis. The Denny reference also discloses printing patient handouts about at least one of the diagnoses and the treatment of the diagnosis represented by a specific diagnosis code. (col. 6, line 51-59; See also col. 10, line 50-col. 11, line 20) This printed prescription provides the patient information on both.

At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system of Evans and Lewis in combination with the teaching of Denny to provide patient handouts related to treatment and printouts of a prescription for treatment. As suggested by Denny, one would have been motivated to include this feature to ensure that the patient is given a proper dosage and special instructions for treatments (Denny: col. 1, lines 42-55) and to facilitate the retrieval and fulfillment of a prescription at a patient-selected pharmacy (col. 7, lines 6-13).

Furthermore, by Appellant's own admission, the limitations of claims 2 and 3 are not new. (page 8 of Appeal Brief, 3rd paragraph "Appellant does not contend that the printing of a prescription code or patient handouts is new or that diagnosis codes are new.") In the present system claims, the appellant have not recited new components or system elements combined in a novel or non-obvious manner, to yield unexpected or unpredictable results. Therefore, it is respectfully submitted that the appellant has failed to overcome the prior art rejection of record.

(E) On pages 8-9, Appellant argues that Mayaud does not disclose the features of claims 12, 21, and 22, because the access to the additional support features is not predicated upon diagnosis code entry.

Again, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The combined teachings of Evans, Lewis and Mayaud have been applied to address the limitations of claims 13, 21, and 22.

Appellant asserts that the references teach away from the claimed invention, and from the applied combination. However, although Mayaud does not expressly disclose the selection of specific of diagnosis codes, the Mayaud reference suggests the advantages of linking the retrieval of support features with the input of diagnosis data. (See col. 38, lines 52-col. 40, line 10).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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